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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/305,892 05/05/99 DALLMIER

A 5244-D1

EXAMINER

IM62/0314

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ART UNIT

PAPER NUMBER

1724

DATE MAILED:

03/14/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/305,892

Applicant(s)  
Dallmier et al.

Examiner  
Betsey Morrison

Group Art Unit  
1724



☒ Responsive to communication(s) filed on May 5, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 15-21 and 23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 15-21 and 23 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1724

1. Examiner acknowledges the entry of preliminary amendments filed on May 5, 1999, which cancels claims 1-14, 22 and 24-27 and amends claims 15-20 and 23. The previous Office Action submitted on February 15, 2000 can be disregarded because it is based on the application as originally filed, prior to the amendments. It is also noted that the application is a divisional of U.S. Patent Serial No. 5,942,126, and is not a CIP of U.S. Patent Serial No. 5,795,487.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 15-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-21 of U.S. Patent No. 5,795,487. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims of the patent and the claims of the instant application are within step c), and step c) of the application claims read on the patented claims. It is submitted that although the application claims are broader with respect to step c) than are the patented

Art Unit: 1724

claims, a step of adding to the unstabilized solution of alkali or alkaline earth metal hypobromite an alkali metal sulfamate is a limitation of the application which reads on the patented claims.

4. Claims 15-21 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-21 of U.S. Patent No. 5,795,487 in view of Goodenough et al. (column 1, line 64-column 2, line 51).

The claims differ from claims 15-21 of U.S. Patent No. 5,795,487 by reciting adding a specific stabilizer to the unstabilized solution of alkali or alkaline earth metal hypobromite, which may or may not include alkali metal sulfamate recited in the patented claims.

Goodenough et al. disclose a process for producing bromide solutions for use as disinfectants comprising adding stabilizers to the solutions, which include stabilizers of the instant claims, other than alkali metal sulfamate. The advantage of adding stabilizers to the bromine solutions is that the solutions are more resistant to degradation than bromine solutions that do not include stabilizers.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the present invention was made, to have included the addition of the stabilizers of Goodenough et al. in the methods of claims of U.S. Patent No. 5,795,487, in order that the solutions become more resistant to degradation.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betsey Morrison whose telephone number is (703) 305-3934. The examiner

Art Unit: 1724

can normally be reached on Monday through Thursday from 8:30 AM to 6:00 PM, and on alternate Fridays from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached at (703) 308-1972. The fax phone number for official after final faxes for this Group is (703)305-3599, for all other official faxes the number is (703)305-7718, and for unofficial faxes the number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



David A. Simmons  
Supervisory Patent Examiner  
Technology Center 1700

Bjm  
B. Morrison  
March 1, 2000